UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,483	02/25/2004	Yutaka Kai	826.1927	1779

21171 7590 10/01/2007

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
PASCAL, LESLIE C	

ART UNIT	PAPER NUMBER
2613	

MAIL DATE	DELIVERY MODE
10/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/785,483	KAI ET AL.	
	Examiner	Art Unit	
	Leslie Pascal	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 7-18-07.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) 5-12,18-22,25,26 and 30-32 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-4,13-17,23,24,27-29,33 and 34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-4, 17, 23-24, 27-29 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iida et al (6597480) in view of Majima et al (5552919).
In the prior art, Iida et al teach a tunable filter (101) which is controlled by a control signal (output of 06), a detection unit (102), a control signal generating unit (103-106) which generates a control signal bases on a detected result obtained by scanning (see element 106) an that the control signal is known for each signal light by the detected result (see element 04). In regard to "the range", they teach scanning which appears that it would be obvious to consider this to be across a range of wavelengths. In regard to claim 2, he uses the detected data and data in memory. In regard to the portion of the claim which says "transmitting and extracting", Majima et al teach that in the prior art figure 1, the signal is extracted only in order to control the filter. Majima et al then teaches transmitting and extracting the signal is well known in order to control the signal and pass it on to other devices. It would have been obvious to transmit and extract the signal in order to control the filter and transmit the optical signal on for further processing at a receiver. In regard to claim 17, in that Iila et al teach determining what the power relation for each wavelength is in order to be stored, it would appear obvious that he must determine what is the maximum power for each wavelength as claimed in claim 17.

In regard to the claims which are drawn to using two points and interpolating in order to determine the control signal, see the last sentence of the abstract. He uses two points to determine the optimum signal. Although Iila et al do not teach specifics about using the adjacent wavelengths, Iila et al teach that it is well known in the prior art to use the adjacent wavelengths to determine the optimal signal (column 1, line 54-column 2, line 4). It would have been obvious to use the adjacent wavelengths as taught by Iila et al is well known in the priori art in order to provide optimal signal in the system of Iila et al.). In regard to claim 14, when the system is modified, it would be obvious to reset the designation information. It would appear that wrong extraction would be avoided. In that in that he teaches calculating by determining between two points, it would have been obvious to use interpolation.

3. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iida et al (6597480) in view of Majima et al (5552919). And further in view of Salomaa (2002/0030868).

Salomaa teaches a filter (32) that receives a WDM signal and is controlled by a control signal (FILTER TUNING signal); detection means (33) a control signal generator (35), which uses situation data (from 36) and the detected signal in order to provide the control signal. In regard to claim 3, see figure 5 in which he show two frequencies at the edge of the band. This appears to be similar to the applicants', which teach that each wavelength can be checked or in the alternative the ends of the band can be determined. In regard to claim 13, he teaches storing the information (paragraph 33). In regard to claim 14, when the system is modified, it would be obvious to reset the

designation information. See paragraph 38. Salomaa teaches that the filter characteristics may change. It would therefore, have been obvious to reset the stored values. In regard to claims 15-16, if no signal is detected, it is obvious, if not inherent that the signal level would be below a specific threshold (which would be a reference). In regard to claim 17, in that Salomaa teaches determining what the power relation for each wavelength is in order to be stored, it would appear obvious that he must determine what is the maximum power for each wavelength as claimed in claim 17. Although it is not clear what is meant by "shifting a wavelength characteristic of the optical tunable filter... of the multiplexed signal". Salomaa's system operates similar to the applicant's system, so it appears that it obviously works in such a way

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-2, 23-24, 27-29 and 33 –34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 17-18 of copending Application No. 10787137. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the copending application claims more elements than the present application, the present application is not patentably distinct. The indicated claims of the copending application claim a filter, detector and control means to control the filter. The known result is obviously the stored results in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Pascal whose telephone number is 571-272-3032. The examiner can normally be reached on Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571-272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leslie Pascal
Primary Examiner
Art Unit 2613